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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,803	10/07/2003	Laurent P. Kosbach	03092CON	6636

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EXAMINER	
GHALI, ISIS A D	

ART UNIT	PAPER NUMBER
1611	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/681,803	KOSBACH ET AL.	
	Examiner	Art Unit	
	Isis A. Ghali	1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 June 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) *13-36* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The receipt is acknowledged of applicants' request for reconsideration filed 06/02/2008.

Claims 1-36 are pending.

This application contains claims 13-36 drawn to an invention nonelected with traverse in the reply filed on 01/19/2007. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 1-12 are included in the prosecution.

The following rejection/objection has been overcome by virtue of applicants' amendment and remarks:

The objections made to the specification.

The following rejections have been discussed in details in the previous office action, and are maintained for reasons of record:

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1-36 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-12, 14-25, and 27-38 of copending Application No. 10/959,614. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

3. The examiner acknowledges that applicants' intention to address this rejection if and when the referenced application issues as a patent and the rejection is no longer provisional. However, the "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US 3,981,988 ('988).

The present claim 1 is directed to composition comprising about 3% or more fumed alumina particles. Fumed alumina particles are defined by applicants as "a form of alumina that is comprised of substantially spherical particles that are fused or aggregated into larger, irregularly shaped aggregate particles".

US '988 disclosed composition comprising alumina spherical particles having primary particle size from 10-100 millimicrons, usually 10-40 millimicrons, which forms aggregates (abstract; col.1, lines 35-39). The alumina aggregates are included in the composition in an amount from 0.1-40%, and usually between 0.5-10% (col.1, lines 43-47; col.4, lines 7-30). Inherently, aggregates will have particle size within the claimed ranges given that the alumina particles disclosed by the reference having particle size between 10-100 millimicrons, i.e. 10-100 nm.

Response to Arguments

6. Applicant's arguments filed 06/02/2008 have been fully considered but they are not persuasive.

Applicants argue that US '988 discloses fumed alumina for use as luster-imparting agent and does not teach any uses of fumed alumina outside of cleaning teeth, or as a component of a cosmetic composition. The preamble of each of the

pending claims indicates that the claims are directed to a "cosmetic composition." Applicants argue that a preamble limits the scope of a claim must be disclosed in a prior art reference for that reference to anticipate the claimed subject matter.

In response to this argument, applicants' attention is directed to the scope of the present claims that is directed to composition, and all the elements of the composition are discussed by the reference as discussed herein after. It is further argued that teeth cleaning and polishing compositions are cosmetic composition as evident by definition of "tooth polishing" provided by "Encyclopedia of Nursing & Allied Health" that stated that: "The American Dental Hygienist Association (ADHA) considers that polishing of the teeth is a cosmetic procedure with little therapeutic benefit." Therefore, using fumed alumina for imparting luster to the teeth is intended for cosmetic procedure of teeth polishing, i.e. providing cosmetic composition. In any events, the recitation of "cosmetic composition" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Further, "cosmetic composition" is directed to intended use and a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to

patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicants argue that US '988 used alumina in combination with abrasive cleaning agents in toothpastes to enhance the luster of teeth.

In response to this argument, applicants' attention is directed to the "comprising" language of the present claims that permits the presence of other ingredients, active or inactive even in major amounts, such as abrasives.

Applicants argue that US '988 fails to disclose a cosmetic composition comprising fumed alumina in any amount, let alone in an amount of about 3 wt.% or more, therefore, does not disclose the subject matter of the pending claims.

In response to this argument, applicants' attention is directed to the claimed amount of fumed alumina that is "about 3% or more as claimed by claim 1, about 5% or more as claimed by claim 2, about 15% or more as claimed by claim 3, and about 30% or more as claimed by claim 4", i.e. the claims encompass broad range from about 3% to any amount more than 30%, and the reference disclosed alumina aggregates are included in the composition in an amount from 0.1-40%. Therefore, in view of the broad claimed amounts of fumed alumina, there is no sufficient specificity of the claimed range, and the range disclosed by the prior art constitutes an anticipation of the claims. See, e.g., *Atofina v. Great Lakes Chem. Corp*, 441 F.3d 991, 999, 78 USPQ2d 1417, 1423 (Fed. Cir. 2006). The claimed range is disclosed by the reference.

Applicants argue that US '988 does not disclose the aggregate particle size of the fumed alumina particles, as required by pending claims 5, 6, 8, 9, and the claimed aggregate particle sizes will not necessarily result from the primary fumed alumina particles disclosed by US '988. Moreover, US '988 does not provide any disclosure regarding the formation of agglomerates of fumed alumina.

In response to this argument, it is pointed out to the disclosure of US '988, col.1, lines 35-39, wherein the reference stated that; "The pyrogenic alumina used in the present invention is produced as generally spherical particles having a primary particle size of about 10 to about 100 millimicrons, usually from about 10 to about 40 millimicrons, which forms aggregates". This teaching further implies that if hypothetically only two particles form an aggregate, then the minimum aggregate particle size will range from about 20 to 200 mililmicron minimally. The claimed aggregate size is broad ranging from about 50 nm or more (claim 5) to about 30,000 miilimicron or less (claim 9). Therefore, no sufficient specificity of the claimed range, and the range disclosed by the prior art constitutes an anticipation of the claims. See, e.g., *Atofina v. Great Lakes Chem. Corp*, 441 F.3d 991, 999, 78 USPQ2d 1417, 1423 (Fed. Cir. 2006). The claimed aggregate particle size is disclosed by the reference.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 7, 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US '988 by itself, or in view of US 2003/0064020 ('020).

The teachings of US '988 are previously discussed in section 6 as set forth in this office action.

However, US '988 does not explicitly teach size distribution of alumina aggregate particles as claimed by claims 7, 10, and 11 or the specific content of alumina phases as claimed by claim 12.

Such size distribution of alumina aggregate particles and specific content of alumina phases, do not impart patentability to the claims, absent evidence to the contrary. It has been held that where the general conditions of a claim are disclosed in

the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller,* 105 USPQ 233.

US '020 teaches alumina particles having δ and θ crystalline form with primary particles thereof having average particle diameter of 5 to 100 nm and secondary particles resulting from aggregation of primary particles having average particle diameter of 50-800 nm (abstract; paragraphs: 0012, 0013, 0029). The lower limit of the particle diameter as disclosed by the reference meets the claimed particle size of "about 50 nm or more", "about 300 nm or less", and "about 30 μm or less". In addition, one of ordinary skill in the art would have reasonably expected that a normal distribution of particle sizes would be achieved in the invention of US '020; therefore, within that distribution approximately half of the particles would have a size above or below this value. Since relative tem "about" was not given explicit definition, this interpretation of the term "average" meets the limitation of "about 70%". Thus, the taught average particle size range discussed by the reference meets the limitations of claims 7, 10, and 11. The reference further teaches primary particles are loosely aggregated to form secondary particles (paragraph 0079), which reads on fumed alumina because applicants disclosed on page 3, paragraph 0016 that fumed alumina is used to refer to alumina primary particles that aggregate to form larger particles. The reference disclosed the use of alumina particles for cosmetic application where scrubbing and smooth feeling are desired (paragraph 0079). The reference further disclosed alumina particles having particle diameter larger than 45 μm (paragraph 0014). The reference disclosed that the particles having diameter larger than 45 μm are contained in an

amount about 0.05%, i.e. the particles having diameter less than 45 μm is present in an amount of 99.05%, which meet the requirement of claims 7, 10 and 11. Regarding claim 12, the reference disclosed the particles are mixed form of δ and θ crystalline alumina particles, i.e. 100% of the particles are mixed form, which reads on the limitation of claim 12 that 30% or more are combined δ and θ crystalline particles, and also the preparation may be all 100% δ particles or all 100% θ particles meeting the limitation of claim12.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide composition comprising alumina particles having particle sizes between 10-100 millimicrons that form aggregate as disclosed by US '988, and provide size distribution of alumina aggregate particles so that the particles having diameter larger than 45 μm are contained in an amount about 0.05%, and the particles having diameter less than 45 μm is present in an amount of 99.05% wherein the particles are mixture form of δ and θ crystalline alumina as disclosed by US '020 because US '020 teaches such alumina particle aggregate is suitable for cosmetic application where scrubbing and smooth feeling are desired, with reasonable expectation of having cosmetic composition comprising mixture of δ and θ alumina aggregated particles so that the particles having diameter larger than 45 μm are contained in an amount about 0.05%, and the particles having diameter less than 45 μm is present in an amount of 99.05% wherein the composition is effectively suitable for cosmetic application where scrubbing and smooth feeling are desired.

Response to Arguments

10. Applicant's arguments filed 06/02/2008 have been fully considered but they are not persuasive.

Applicants hereby repeat the argument regarding US '988, and further argue that one having ordinary skill in the art would not reasonably be expected to optimize anything in its disclosure to arrive at the claimed invention.

In response to this argument, it is argued that the amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize especially in view of the disclosure of the reference and in view of the broad ranges of the claims. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of applicant's invention.

Applicants argue that US '020 fails to cure the deficiencies of the US '988 as it does not teach the amount of fumed alumina and the cosmetic composition. US '020 is not directed to cosmetic compositions and discloses fumed alumina particles exhibiting primary and secondary particle diameters that exhibit improved abrasive properties in polishing applications, while simultaneously reducing scratching because of a reduced amount of coarse particles. While US '020 publication makes a singular, generic

reference to cosmetic compositions, stating that "the alumina particles can be used for not only the CMP application, but also the cosmetics application where scrubbing and smooth feeling both are desired" (paragraph 0079), nothing in the reference discloses the particular soft-focus benefits provided by the use of fumed alumina.

In response to these arguments, it is argued that the US '988 teaches the claimed amounts and cosmetic composition as set forth in section 6 of this office action. Applicants themselves admit that suggestion of cosmetic application is made by US '020 in paragraph 0079. Therefore the reference specifically teach the utility of fumed alumina (as admitted by the applicant) in cosmetics. This teaching is sufficient to motivate and support the use of their alumina particles by one or ordinary skill in the art at the time of the invention in a cosmetic composition. Further, "the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem". It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)" (see MPEP 2144 section IV). In evaluating the disclosure of the reference, it is proper to take into account not only the specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). In this case the reference clearly suggested cosmetic use of alumina particles. The reference further provides benefit of using alumina particles which is smooth feeling. Hence, US '020 is applicable under U.S.C. 103.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., soft focused benefit) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants argue that US '020 teaches large average aggregate particle size, i.e., between 50 and 800 nm, teaches nothing with respect to the particular average aggregate particle size required by the pending claims, i.e., 300 nm or less, nor with respect to the particle size distribution required by the pending claims, i.e., 70 wt.% or more of the particles having an average aggregate particle size of 300 nm or less.

In response to this argument, it seems that applicants themselves admit that US '020 teaches aggregate particle size encompassing the broad range of aggregate particle size. The claimed range of about 5 nm or more to less than 300 nm overlaps with the range of 50 nm to 800 nm disclosed by the reference. Regarding the particle size distribution, one of ordinary skill in the art would have reasonably expected that a normal distribution of particle sizes would be achieved in the invention of US '020; therefore within that distribution approximately half of the particles would have a size above or below this value. Since the relative term "about" was given no explicit definition, this interpretation of the term "average" meets the limitation of "about 70

wt%". Thus, the taught average particle size range discussed above also meets the limitations of instant claims 7, 10 and 11.

Applicants argue that US '020 discloses fumed alumina that "can be amorphous or have any of the: crystalline forms, for example δ-form, and θ-form" (paragraph 0028; see also paragraph 0046). Thus, Contrary to the Office Action's assertions, the particles of US '020 can include, for example, non-crystalline amorphous particles, therefore, US '020 does not indicate that the particles comprise a combined δ-phase and θ-phase crystalline alumina content of about 30% or more.

In response to this argument, applicants' attention is directed to the claims' language that includes open-ended upper limit of crystalline alumina, i.e. 30% or more. US '020 teaches the use of δ or θ crystalline forms. So preparations that are all (100%) δ or all (100%) θ meet the limitation of claim 12. It is well established that the claims are given the broadest interpretation during examination. A conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute predictability, only a reasonable expectation of success; and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been *prima facie* obvious within the meaning of 35 U.S.C. 103 (a).

11. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/056846 ('486) in view of US '020.

WO '486 teaches cosmetic composition comprising alumina particles have an average particle size of about 10 to about 20 microns, and present in an amount from 0.1 to 10% of the composition (page 4, lines 23-30; page 11, claims 1-10).

WO '486, however, does not teach aggregate of alumina particles to form fumed alumina as claimed by claim 1, and the size and phase distribution of the particles as instantly claimed by claims 5-12.

The aggregated alumina particles, their sizes, and size and phase distribution are all disclosed by US '020. Further US '020 teaches suitability of such aggregated alumina in cosmetic composition, as set forth in section 11 of this office action.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide cosmetic composition comprising alumina particles having particle sizes between 10-20 millimicrons as disclosed by WO '486, and replace alumina particles with aggregate of alumina particles with size distribution that particles having diameter larger than 45 μm are contained in an amount about 0.05%, and the particles having diameter less than 45 μm is present in an amount of 99.05% wherein the particles are mixture form of δ and θ crystalline alumina as disclosed by US '020 because US '020 teaches such alumina particle aggregate is suitable for cosmetic application where scrubbing and smooth feeling are desired, with reasonable expectation of having cosmetic composition comprising mixture of δ and θ alumina aggregated particles so that the particles having diameter larger than 45 μm are

contained in an amount about 0.05%, and the particles having diameter less than 45 μm is present in an amount of 99.05% wherein the composition is effectively suitable for cosmetic application where scrubbing and smooth feeling are desired.

Response to Arguments

12. Applicant's arguments filed 06/02/2008 have been fully considered but they are not persuasive.

Applicants argue that WO '846 fails to disclose or suggest the use of fumed alumina particles in cosmetic compositions whatsoever, and the reference uses "combination of pigments" to provide a soft-focus effect in cosmetic compositions. WO '846 teaches that the alumina platelet is a planar mirrored particle that is treated with a metal oxide. Thus, WO '846 fails to disclose a cosmetic composition comprising fumed alumina in the claimed amount.

In response to this argument, applicants' attention is directed to the teaching of WO '846 that teaches alumina particles have an average particle size of about 10 to about 20 microns, and present in an amount from 0.1 to 10% of the composition. Further WO '846 examples are directed to foundation, i.e. cosmetic composition. Additionally, the claims' language does not exclude the presence of other pigments or the treatment with metal oxide.

Applicants hereby repeat the argument regarding US '020, therefore the examiner response as in section 10 of this office action is repeated.

Applicants argue that a person of ordinary skill in the art would not have been motivated to modify or combine the disclosures of US '020 and WO '846 because US '020 is directed to controlling the average particle diameter of fumed alumina, and the use of these particles to produce specific advantages in CMP applications and WO '846, on the other hand, directed to cosmetic compositions and requires treated alumina platelets as pigments, and distinguishes cosmetic compositions comprising metal oxides in any form (seep. 6, lines 20-35), while the present compositions is substantially free of metal oxides. Thus, WO '846 teaches away from the use of all metal oxides, including fumed alumina, to provide a soft-focus effect.

In response to this argument, it is argued that the present invention is directed to composition, and all the elements of the composition are taught by the combined teachings of the references. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both prior art references are in the field of applicant's endeavor as both disclosed cosmetic composition, and are reasonably pertinent to the particular problem with which the applicant was concerned, which is forming cosmetic composition.

Further, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide cosmetic composition comprising alumina particles having particle sizes between 10-20 millimicrons as disclosed by WO '486, and replace alumina particles with aggregate of alumina particles with size distribution that particles having diameter larger than 45 μm are contained in an amount about 0.05%, and the particles having diameter less than 45 μm is present in an amount of 99.05% wherein the particles are mixture form of δ and θ crystalline alumina as disclosed by US '020 because US '020 teaches such alumina particle aggregate is suitable for cosmetic application where scrubbing and smooth feeling are desired, with reasonable expectation of having cosmetic composition comprising mixture of δ and θ alumina aggregated particles so that the particles having diameter larger than 45 μm are contained in an amount about 0.05%, and the particles having diameter less than 45 μm is present in an amount of 99.05% wherein the composition is effectively suitable for cosmetic application where scrubbing and smooth feeling are desired.

The disclosed examples and preferred embodiment do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the present compositions is substantially free of metal oxides) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis A. Ghali whose telephone number is (571) 272-

0595. The examiner can normally be reached on Monday-Thursday, 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on (571) 272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Isis A Ghali/
Primary Examiner, Art Unit 1611

IG